

REMARKS

Claims 58-80 are pending in this application. Claim(s) 58-80 are amended, and claim(s) 81 is added herein.

Claim(s) 58, 69 and 80 are independent.

The Examiner notes that the substitute specification filed on July 23, 2001, has not been entered. The non-entered substitute specification is hereby withdrawn. A substitute specification having proper margins and conforming to 37 C.F.R. 1.125(b) is submitted herewith. Additionally, substitute informal Figures 1-29 with corrected margins are also submitted herewith. No new matter is added.

Priority is requested in and amendment of the specification to insert a related application statement is made in the submittal originally requesting this continuation application under 37 C.F.R. 1.53(b). Please see item 7 on page 2 of the originally filed submittal which requests that a sentence be added before the first line of the parent specification filed in the present application, which states that the application is a continuation of pending application Serial No. 09/749,596, filed on December 28, 2000.

Hence, priority was requested at the time of filing the present application, and the application has been amended to include an appropriate related application statement.

The Examiner notes the defect in the filed Oath or Declaration. As discussed with the Examiner, Applicants are relying on the original Declaration filed in the parent '596 application, a copy of which is submitted herewith. As indicated on page 2, item 1b, in the original submittal form, inventors Tim Herdklotz and Cheryl Ward, who are inventors named in the parent '596 application, are deleted from the present application.

Accordingly, the inventors in the present application are limited to Messrs. Ganesan, Renshaw and Kight, all of whom are also named inventors in the parent '596 application.

Claims 58, 60-62, 64, 66-69, 71-73, 75 and 77-80 stand rejected under 35 U.S.C. §103(a) as obvious over Van Dusen (U.S. Patent No. 6,175,823) in view of the Lenhart publication (Lenhart, J. "Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity," the Washington Post (December 20, 1998)). Claims 59 and 70 stand rejected under 35 U.S.C. §103(a) as obvious over the base combination in further view of Walker (U.S. Patent No. 6,138,106). Claims 63 and 74 stand rejected under 35 U.S.C. §103(a) as obvious over the base combination in further view of the "WishClick" publication in Business Wire. Claims 65 and 76 stand rejected under 35 U.S.C. §103(a) as obvious over the base combination in further view of Solokl et al. (U.S. Patent No. 6,173,269). The rejections are respectfully traversed.

The claims are amended to delete unnecessary limitations and for clarification, and not for other reasons of patentability.

Claim 1 requires the receipt of a request to send an electronic greeting card and make an associated monetary gift on behalf of a requesting donor to a designated recipient. Further required is the processing of the received request to generate an electronic greeting card, including a notification of the monetary gift.

The Examiner relies on Van Dusen as teaching the receipt of a request to make a monetary gift, the processing of a notification of the monetary gift, and the crediting of funds equal to the monetary gift amount to a deposit account associated with the recipient.

However, independent claim 58, for example, requires the processing of a received request to make a monetary gift and not the notification of the monetary gift which is sent

to the recipient. The relied upon in column 2, lines 55-57, lacks any teaching or suggestion of the required processing of the received request to generate a notification of the monetary gift for transmission to the designated recipient.

Furthermore, while acknowledging that Van Dusen does not teach the generation of an electronic greeting card including a notification of a monetary gift or the transmission of such an electronic greeting card to the recipient, the Examiner contends that it would have been obvious to combine Lenhart's teachings relating to the transmission of electronic greeting cards with personal messages with Van Dusen, to thereby modify Van Dusen to process a donor's request to generate an electronic greeting card which includes a notification of a monetary gift and to transmit such a greeting card to the designated recipient.

It is respectfully submitted that in rejecting claims under 35 U.S.C. §103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is required to make the factual determination set forth in Graham v. John Deere Co. of Kansas City (148 USPQ 459 (1966)), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine the prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole. It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious.

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986)). In determining the issue of obviousness, we must look to the collective teachings of the references relied upon and to whether the hypothetical person of ordinary skill in the art, familiar with such teachings would have found it obvious to make a corresponding structure or process to that being claimed (See In re Fritch (23 USPQ 1780 (Fed. Circ. 1992))).

The test for combining references is not what the individual references themselves suggest, but rather what the combination of disclosures taken at a whole would suggest to one of ordinary skill in the art. In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Obviousness cannot be properly established by simply showing that each claimed element may be found somewhere in the prior art (See Hartness International, Inc. v Simplimatic Engineering Co. (2 USPQ 2d 1826 (Fed. Circ. 1987)). Without a suggestion of the invention in the prior art reference combination, there is no motivation to combine the references. Simplicity and hindsight are not proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). The mere possibility that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. In the absence of such a suggestion the basis for the rejection can only be viewed as

nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

The issue is not whether it is within the skill of the art to make the proposed modifications, but rather if one skilled in the art, on consideration of the references, would have found it obvious to do so. It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and (In re Keller 208 USPQ 817 (CCPA 1981)).

It is respectfully submitted that the Examiner's basis for the obviousness rejection is not based on what the prior art shows, teaches or suggests, but rather by whether, in the Examiner's view, one of ordinary skill could have found the invention easy to conceive. Such a position is unsupported by any case law, and such simplicity and hindsight are not proper criteria for resolving obviousness (See In re Warner, supra).

It is further respectfully submitted that there is nothing within any of the applied art teachings which would suggest the Examiner's proposed modification to Van Dusen to arrive at the invention claimed in the present application. Rather, Van Dusen lacks any suggestion that the disclosed gifts should or could be requested in association with a request to send an electronic greeting card, or how such a request could be processed to generate an electronic greeting card providing a notification of a monetary gift which could then be transmitted to a designated recipient.

The relied upon disclosure in text column 2, lines 55-65, in Van Dusen neither teaches nor suggests the processing of a received request from a requesting donor and

lacks any suggestion that it could or would be beneficial to somehow combine the notification of a gift with a greeting card. Lenhart, on the other hand, although recognizing certain benefits of electronic greeting cards, fails to, in any way, suggest that such cards could be combined with a gift. Hence, one can only ask what in the applied prior art suggests modifying Van Dusen as proposed on the basis of the disclosure of Lenhart.

As the Federal Circuit recently reiterated, if there is no suggestion or motivation to combine the references in the prior art itself, there is no basis for the combination. Reliance on common knowledge and/or common sense cannot be the basis of finding obviousness (See In re Lee 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible. Accordingly, it is respectfully submitted that independent claims 58, 69 and 80 patentably distinguish over the applied prior art.

Furthermore, other features recited in the dependent claims further and independently distinguish over the applied prior art. For example, claim 64 requires that a payment account, at a financial institute associated with the requesting donor, be debited after activation of a hyperlink included in the transmitted greeting card. The Examiner relies on Van Dusen's disclosure in column 3, lines 55-63, as teaching such a limitation. However, the relied upon text discloses that the donor's account is debited prior to any notification of the gift being transmitted to the designated recipient and hence, prior to the activation of any such hyperlink.

Claim 66 requires that the request be received from an electronic greeting card service. The Examiner points to column 3, lines 38-63, of Van Dusen in support of the

rejection of this claim. However, in view of the Van Dusen's lack of any disclosure whatsoever regarding gift cards, Van Dusen lacks any teaching or suggestion of a request being received from an electronic greeting card service.

Claim 67, as amended, requires that the request be received, the received request be processed, and the generated electronic greeting card be transmitted by an electronic greeting card service, while the crediting of the funds be directed by a payment service provider. It is respectfully submitted that there is nothing within the applied prior art, taken in any combination, which would suggest such a distribution of functionality.

In support of the rejection of claim 68, the Examiner acknowledges Van Dusen's lack of any disclosure of a greeting card service transmitting a greeting card, but proposes to modify Van Dusen based on Lenhart to somehow transmit an electronic greeting card to an electronic greeting card service prior to the electronic greeting card being transmitted to the designated recipient. The Examiner's rationale is not understood. Van Dusen lacks any disclosure of electronic greeting cards or the transmission thereof. Lenhart teaches that the greeting card service directly receives requests for electronic greeting cards and transmits the electronic greeting cards to the designated recipients. Accordingly, there is nothing within the applied combination of art which would in any way suggest that an electronic greeting card be transmitted from, for example, a payment service provider to an electronic greeting card service provider.

Claim 59 requires that the electronic greeting card notifying a designated recipient of a monetary gift be transmitted either (i) subsequent to the processor directing the crediting of the funds to the deposit account or (ii) concurrent therewith. The Examiner acknowledges that the primary combination of Van Dusen and Lenhart fails to disclose

such limitations. Accordingly, the Examiner proposes to further modify the base combination based on Walker's teaching of the redemption of an electronic gift certificate which is paid for either prior to or after being redeemed. The Examiner's position is not understood. Claim 59 relates to the crediting of funds corresponding to the monetary gift to a deposit account and not to the subsequent use of that gift. Hence, the relevance of the applied Walker disclosure is unclear. Walker, to the extent notification of the gift certificate is disclosed, necessarily requires that notification be prior to (not subsequent to or concurrent with) a crediting of the gift to the recipient.

In rejecting claim 63, the Examiner again acknowledges that the primary combination of Van Dusen and Lenhart fails to disclose the required limitations, but proposes to modify the base combinations in view of the disclosure in WishClick to overcome the deficiency in the primary combination. However, claim 63 requires that a transmitted greeting card to a designated recipient be further transmitted to a non-designated recipient, so that the non-designated recipient can have the monetary gift credited to his/her account. The WishClick reference discloses nothing more than a gift to designated recipients who successfully register others. Accordingly the relevance of WishClick to the limitations recited in claim 63 is not understood.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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APPENDIX TO RESPONSE TO OFFICIAL ACTION DATED NOVEMBER 25, 2002

AMENDMENTS TO CLAIMS

(DELETIONS IN BRACKETS AND ADDITIONS UNDERLINED)

58. (TWICE AMENDED) A method for making a monetary gift, comprising:

receiving, via a network, a request to send an electronic greeting card and to make [a] an associated monetary gift in an amount, on behalf of a requesting donor[,] to a designated recipient [, and an input associated with an electronic greeting card];

processing the received request [and the input] to generate the electronic greeting card including a notification of the monetary gift;

transmitting, via the network, the generated electronic greeting card to the designated recipient; and

directing a crediting of funds equal to the monetary gift amount to a deposit account [associated with the recipient].

Note claims 60

+ 63

59. (TWICE AMENDED) The method of claim 58, wherein the electronic greeting card is transmitted to the designated recipient at one of 1) a time subsequent to the directing of the crediting of the funds to the deposit account [associated with the recipient], and 2) a time concurrent with the directing of the crediting of the funds to the deposit account [associated with the recipient].

60. (TWICE AMENDED) The method of claim 58, wherein:

the [notification] electronic greeting card includes a hyper-link; [and]

the funds are directed to be credited to the deposit account [associated with the recipient] subsequent to an activation of the hyper-link; and

[
the deposit account is at a financial institution.

61. (TWICE AMENDED) The method of claim 60, further comprising:

activating the hyper-link; and

receiving, via the activated hyper-link, information identifying the designated recipient;

wherein the funds are directed to be credited to the deposit account [associated with the recipient] subsequent to receipt of the information identifying the recipient;

wherein the deposit account is associated with the designated recipient.

62. (TWICE AMENDED) The method of claim 61, further comprising:

processing the received information identifying the designated recipient to determine if the designated recipient is a member of an enclosed community prior to the directing of the crediting of the funds to the deposit account associated with the designated recipient; and

if it is determined that the designated recipient is not a member of the enclosed community, transmitting a notice, via the network, to the designated recipient, that the designated recipient must become a member of the enclosed community before the funds [will] are directed to be credited to the deposit account associated with the designated recipient.

63. (TWICE AMENDED) The method of claim 58, wherein [the recipient is a first recipient and] the [notification] electronic greeting card includes a hyper-link, and further comprising:

further transmitting, via the network, the transmitted electronic greeting card including the hyperlink and the notification of the monetary gift to a [second] non-designated recipient;

activating the hyper-link in the further transmitted electronic greeting card;
receiving, via the activated hyper-link, information identifying [a second] the non-designated recipient;

processing the received information identifying the [second] non-designated recipient to determine if the [second] non-designated recipient is a member of an enclosed community;

if it is determined that the [second] non-designated recipient is not a member of the enclosed community, transmitting a notice, via the network, to the [second] non-designated recipient, that the [second] non-designated recipient must become a member of the enclosed community before funds are directed to be credited to [a] the deposit account [associated with the second recipient]; and

if it is determined that the [second] non-designated recipient is a member of the enclosed community, directing the crediting of the funds equal to the monetary gift amount to [a] the deposit account [associated with the second recipient];

wherein the deposit account is at a financial institute and is associated with the non-designated recipient.

64. (TWICE AMENDED) The method of claim 58, further comprising:

debiting [an] a payment account at a financial institute associated with the requesting donor;

wherein the payment account associated with the requesting donor is debited at [one of (1) a time prior to transmitting the electronic greeting card to the recipient, and (2)] a time subsequent to an activation of a hyper-link included in the transmitted electronic greeting card.

65. (TWICE AMENDED) The method of claim 58, further comprising:

processing the received request to determine if the designated recipient is a member of an enclosed community prior to processing the request [and the input] to generate the electronic greeting card including [a] the notification of the monetary gift;

wherein, if it is determined that the designated recipient is not a member of the enclosed community, the [notification] transmitted electronic greeting card includes a notification that the recipient must become a member of the enclosed community before the funds [will] are directed to be credited to the deposit account [associated with the recipient].

66. (TWICE AMENDED) The method of claim 58, wherein [both] the request [and the input are] is received from [one of 1) the donor, and 2)] an electronic greeting card service.

67. (TWICE AMENDED) The method of claim 58, wherein:

the request is received by [from the donor and the input is received from], the received request is processed by and the generated electronic greeting card is transmitted by an electronic greeting card service; and
the crediting of the funds is directed by a payment service provider.

68. (TWICE AMENDED) The method of claim 58, further comprising:

transmitting, via the network, the generated electronic greeting card to an electronic greeting card service prior to transmitting the electronic greeting card to the designated recipient.

69. (TWICE AMENDED) A system for making a monetary gift, comprising:

a communications port configured to [transmit and] receive [information] a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, via a network;

[a memory configured to store information associated with monetary gifts;] and
a processor [in communication with the communications port and the memory and] configured to [(1) receive, from the communications port, a request to make a monetary gift in an amount on behalf of a donor, to a recipient, and an input associated with an electronic greeting card, (2) cause the memory to store the request, (3)] process the received request [and the input] to generate the electronic greeting card including a notification of the monetary gift[.];

[(4) cause] wherein the communications port is further configured to transmit the electronic greeting card [to be transmitted] to the designated recipient via the network[.];

[and (5) cause] wherein the processor is further configured to direct funds equal to the monetary gift amount to be credited to a deposit account [associated with the recipient].

70. (TWICE AMENDED) The system of claim 69, wherein the processor is further configured to cause the electronic greeting card to be transmitted to the recipient at one of 1) a time subsequent to the directing of the crediting of the funds to the deposit account [associated with the recipient], and 2) a time concurrent with the directing of the crediting of the funds to the deposit account [associated with the recipient].

71. (TWICE AMENDED) The system of claim 69, wherein:

the generated electronic greeting card [notification] includes a hyper-link; [and]
the [processor] communications port is further configured to [(1)] receive[, from the communications port,] information via the network over [indicating an activation of] the hyper-link [, and];

the processor is further configured to direct [(2) cause] the funds to be credited to the deposit account [associated with the recipient] subsequent to receipt of the information [indicating an activation of] over the hyper-link; and
the deposit account is at a financial institute.

72. (TWICE AMENDED) The system of claim 71, wherein:

the [processor is further configured to (1) receive,] information received via the network over the [activated] hyper-link, [information identifying] identifies the designated recipient[, and];

the processor is further configured to direct [(2) cause] the funds to be credited to the deposit account [associated with the recipient] subsequent to receipt of the information identifying the designated recipient; and

the deposit account is associated with the designated recipient.

73. (TWICE AMENDED) The system of claim 72, wherein:

the processor is further configured to (1) process the received information identifying the designated recipient to determine if the designated recipient is a member of an enclosed community prior to the directing of the crediting of the funds to the deposit account associated with the designated recipient, and (2) if it is determined that the designated recipient is not a member of the enclosed community, cause the communications port to transmit a notice to the designated recipient that the designated recipient must become a member of the enclosed community before the funds [will be] are directed to be credited to the deposit account associated with the designated recipient.

74. (TWICE AMENDED) The system of claim 69, wherein:

[the recipient is a first recipient;]

the [notification] generated greeting card includes a hyper-link; and

the [processor] communications port is further configured to [(1)] receive, [from the communications port] via the network over the hyper-link, information identifying a

[second] non-designated recipient subsequent to a transmission of the electronic greeting card [from the first recipient to the second recipient, and];

[(2)] the processor is further configured to process the information identifying the [second] non-designated recipient to determine if the [second] non-designated recipient is a member of an enclosed community;

if it is determined that the [second] non-designated recipient is not a member of the enclosed community, the processor is further configured to cause the communications port to transmit a notice [to be transmitted] to the [second] non-designated recipient, via the network, that the [second] non-designated recipient must become a member of the enclosed community before the funds [will] are directed to be credited to [a] the deposit account [associated with the second recipient]; and

if it is determined that the [second] non-designated recipient is a member of the enclosed community, the processor is further configured to [cause] direct the funds equal to the monetary gift amount to be credited to [a] the deposit account [associated with the second recipient];

wherein the deposit account is at a financial institute and is associated with the non-designated recipient.

75. (TWICE AMENDED) The system of claim 69, wherein:

the processor is further configured to [cause] direct funds to be debited from [an] a payment account associated with the requesting donor; and

the payment account associated with the donor is directed [caused] to be debited at [one of (1) a time prior to the processor causing the electronic greeting card to be

transmitted to the recipient, and (2)] a time subsequent to an activation of a hyper-link included in the transmitted electronic greeting card.

76. (TWICE AMENDED) The system of claim 69, wherein:

the processor is further configured to process the request to determine if the designated recipient is a member of an enclosed community prior to [processing the request and the input to generate] generating the electronic greeting card including [a] the notification of the monetary gift; and

if it is determined that the designated recipient is not a member of the enclosed community, the [notification] generated electronic greeting card includes a notification that the designated recipient must become a member of the enclosed community before the funds [will] are directed to be credited to the deposit account [associated with the recipient].

77. (TWICE AMENDED) The system of claim 69, wherein [both] the request [and the input are] is received from [one of 1) the donor, and 2)] an electronic greeting card service.

78. (TWICE AMENDED) The system of claim 69, wherein the request is received [from the donor and the input is received from] by an electronic greeting card service.

79. (TWICE AMENDED) The system of claim 69, wherein the [processor] communications port is further configured to transmit, via the network [and through the communications

port], the generated electronic greeting card to an electronic greeting card service [prior to causing the electronic greeting card to be transmitted to the recipient].

80. (TWICE AMENDED) An article of manufacture for making a monetary gift, comprising:

a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

receive[, via a network,] a request to make a monetary gift [in an amount] on behalf of a requesting donor[,] to a designated recipient, and [an input] to send an associated [with an] electronic greeting card;

[process the request and the input to] generate the electronic greeting card including a notification of the monetary gift, based on the received request;

cause the electronic greeting card to be transmitted[, via the network,] to the designated recipient; and

cause funds equal to the monetary gift amount to be credited to a deposit account [associated with the recipient].